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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/905,501	08/04/97	SCROGGIE	M CAT/29US

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LM02/1112

EXAMINER
KAZIMI, H

ART UNIT	PAPER NUMBER
2765	5

DATE MAILED: 11/12/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/905,501

Applicant(s)
Scroggie et al.

Examiner
Hani Kazimi

Group Art Unit
2765



☒ Responsive to communication(s) filed on Aug 4, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-31 is/are pending in the application.

Of the above, claim(s) 1-27 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 28-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This office action is a response to the application filed on August 4, 1997. The rejections cited are as stated below:

Status of Claims

2. This application has been reviewed. Of the original claims 1-27, claims 1-27, have been canceled without prejudice in the amendment filed on August 4, 1997, claims 28-31, have been added in the same amendment. Therefore, claims 28-31, are under prosecution in this application.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 28-31, are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. Specifically the claims are directed towards an abstract idea.

Claims 28-31, represent an abstract idea that does not provide a practical application in the technological arts. Also the claims do not appear to correspond to a specific machine or manufacture disclosed with in the specification and thus encompass any product of the class

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configured in any manner to perform the underlying process. In the instant claims the functional descriptive material is a computer program per se. Consequently, the claims are analyzed based upon the underlying process and thus rejected as being directed to a non-statutory process.

The following preamble is suggested:

"A computer implemented method for distributing purchasing ---", or "A method --- to retail customers through a computer network, comprising ---", or something similar.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

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7. Claims 28-31, are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien Europ. Patent No. 0512509A2 in view of SLED (Internet Directory Distributes Electronic Coupons).

Claim 28, O'Brien teaches a method for distributing purchasing incentives to retail customers (abstract), comprising the steps of:

maintaining a consumer purchase history database derived in part from accumulated purchase data of identifiable consumers (column 5, lines 40-45);

obtaining personal information from a consumer (column 7, line 56 thru column 8, line 16);

maintaining a consumer personal database for each consumer having a file, to store information contained in the file of the consumer (column 5, lines 14-29);

generating purchase incentives for the consumer based in part on prior purchasing behavior and on personal information known from the consumer's personal database (column 5, lines 40-46);

updating the file to include the generated purchase incentives (column 5, lines 21-29); and
transmitting an advisory message to the consumer concerning the updated file (column 5, lines 21-29).

O'Brien fails to explicitly teach the step of establishing a personal page in a computer

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network, for any consumer who requests one, based in part on the personal information obtained from the consumer, wherein the personal page contains information about incentives directed specifically to the consumer associated with the page.

However, SLED teaches the use of the Internet to obtain electronic coupons good for discounts on a variety of products, wherein SLED members can obtain a listing of current coupons, retrieve, and submit them to vendors (paragraphs 1, and 2);

Both O'Brien and SLED fail to teach the step of establishing a personal page in a computer network, for any consumer who requests one, wherein the personal page contains information about incentives directed specifically to the consumer associated with the page.

Official notice is taken that establishing a personal page in a computer network, for any consumer who requests one, wherein the personal page contains information about incentives directed specifically to the consumer associated with the page is old and well known in the art.

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of O'Brien to include the establishing step of a personal page in a computer network, for any consumer who requests one, based in part on the personal information obtained from the consumer, wherein the personal page contains information about incentives directed specifically to the consumer associated with the page because, the use of personal pages on the Internet will cover a broader range of distribution.

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Claim 29, O'Brien teaches a method for distributing purchasing incentives to retail customers (abstract), comprising the steps of:

transmitting promotional materials pertaining to product discounts, to a consumer's remote terminal (column 5, lines 2-13);

displaying the promotional materials pertaining to product discounts at the consumer's remote terminal (column 4, lines 40-53);

receiving consumer selections of product discounts, made at the consumer's remote terminal (column 5, lines 1-4);

in response to the consumer selections, generating a token and transmitting it to the consumer's remote terminal, wherein the token identifies the consumer (column, lines 44-54);

scanning the token in a retail store, together with items purchased by the consumer (column 8, lines 17-24);

verifying that the discounted items selected by the consumer at the consumer's remote terminal were purchased by the consumer (column 8, lines 17-33); and

generating a voucher that provides a cash discount to the consumer, the cash discount being the total of all verified item discounts selected by the consumer (column 9, lines 13-18).

O'Brien fails to explicitly teach the step of making online discounted product selections;

However, SLED teaches the step of making online discounted product selections; (paragraphs 1, and 2);

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Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of O'Brien to include the step of making online discounted product selections as taught in the system of SLED because, the use of online services provide a great incentive for Internet users.

Claims 30, and 31, O'Brien teaches the step of generating a voucher generates a voucher that is redeemable on a subsequent store visit (column 10, lines 11-24).

O'Brien teaches the step of generating a voucher for immediate customer distribution (column 2, lines 29-37).

O'Brien fails to explicitly teach that the voucher is an instantly redeemable voucher.

However, an instantly redeemable voucher is old and well known in the art. Official notice is taken thereof. It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to include the step of instantly redeem a voucher for the convenience of the customer.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Von Kohorn US Patent 5,249,044 Sep. 28, 1993.

b) Stein et al. US Patent 5,459,306 Oct. 17, 1995.

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9. Any inquiry concerning this statement or earlier statements from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached on Monday - Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners' supervisor, Allen Macdonald, can be reached at (703) 305-9708. The fax phone number for this Group is (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Hani Kazimi.

November 9, 1998.



ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINER